



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/802,171

03/17/2004

Ellen Lasch

37355-237

3870

7590

04/21/2005

Stephen T. Scherrer
McDermott, Will & Emery
227 West Monroe
Chicago, IL 60606-5096

EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

Office Action Summary

Application No.

10/802,171

Applicant(s)

LASCH ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7,9,10,13-15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-24 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,9,10 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment of 3 February 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 2, 4, 5, 7, 9, 10, 13-15, and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda (US 5,004,899) in view of Combaluzier (US 5,973,475).

Re claim 1, Ueda teaches a foldable transaction card (FIG. 1A). Ueda teaches that the card is used with an external read/write device when it is unfolded (col 2, lines 4+). Re claim 7, Ueda teaches the foldable card comprises a first and second section with a hinge/hinging means disposed there between (FIG. 1a+). Re claims 10 and 17, the Examiner has interpreted the

portion of the card (1) containing IC (7) (of Ueda) as the second portion, which contains an electronic storage means for storing information readable by a reader. Though Ueda is silent to a portable electronic device, the Examiner notes that it is well known and conventional in the art to read/write cards with portable electronic devices (for convenience, for example).

Specifically, re claims 1-2, Combaluzier teaches a portable electronic device (mobile telephone) that accepts chip/transaction cards (FIG. 2). Re claim 4, Combaluzier teaches that the card is removable from the device (slot 3 and FIG. 1). Re claim 5, Combaluzier teaches that the card is disposed within a housing (2) interconnected with the portable device (phone). The Examiner also notes that the sleeve 26 can also be interpreted as a housing interconnected with the phone, that has the card disposed therein. Re claim 9, Combaluzier teaches the card is removable disposed within the housing (slot 3 showing the card removably disposed within the device or FIG. 1 which teaches the card removable disposed from the sleeve 26 of the device). Re claim 10, as the card is inserted into the housing of the device it is broadly interpreted as attached to the housing, such means being an obvious expedient to secure the card for processing. Re claim 13, as the card is sandwiched in the housing, through entry by the slot, it is interpreted to include attaching means. Re claim 14, Combaluzier teaches a slot to insert the card, but is silent to a track attached to the housing. The Examiner notes that tracks/guides are well known and conventionally used in a card reader to facilitate correct orientation/insertion of the card. Therefore it would have been obvious to an artisan of ordinary skill in the art to modify the teachings of Combaluzier as a means to provide guide means to facilitate correct card insertion. Such modifications are well known and conventional in the art, and produce expected results (see US 5,912,446 FIG. 2 as an example of attaching means/track/guide means of a card

reader to guide the card insertion). Re claim 15, Combaluzier teaches an opening slot, but is silent to an opening means for opening the housing to access the card therein. The Examiner notes that flaps/gates/doors/panels to cover an opening of an electrical device, such as a floppy disk drive, automobile tape player, card reader, etc. are well known and conventional means of protecting internals of the device (among other reasons) while also permitting the ejection and inserting of the appropriate medium. The Examiner notes that simply using a cover to cover the opening of the card reader is obvious to one of ordinary skill in the art, to protect the internals of the device, for example (see US 2001/0010608 and US 2001/0003071 which teaches a phone with a card reader and opening means 25 to access the cards therein). The Examiner notes that simply providing a covering to an opening is obvious and well within the skill in the art for protection. Re claim 17, as discussed above, the card is readable by a reader. Re claim 18, Combaluzier teaches the housing is removable from the transaction device (as the battery 1 is removable). Re claim 19, the Combaluzier teaches the card is removable from the housing (slot 3 and FIG. 1 for example).

3. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda/Combaluzier, as discussed above, in view of Pentz et al. (US 6,471,127).

The teachings of Ueda have been discussed above. Ueda teaches a foldable transaction card that is foldable to protect the circuitry (col 2, lines 25+). The use of a portable reader to read cards has been discussed above as well known and conventional. Combaluzier has taught a portable card reader.

Ueda/Combaluzier are silent to the card having at least one dimension smaller than a traditional transaction card when the transaction card is in an unfolded state.

Pentz et al. teaches a chip/magnetic stripe card with dimensions smaller than a traditional transaction card (abstract).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Ueda/Combaluzier with those of Pentz et al.

As Ueda is relied upon to teach a foldable electronic card that can protect the components, the teachings of Pentz et al. reduce the size of the card. Therefore, one would have been motivated to combine the teachings in order to have a reduced size card (for convenience) that can still be read by readers, while also still maintaining protection of the card so that it can be read/processed.

Response to Arguments

1. Applicant's arguments with respect to claims 1, 2, 4, 5, 7, 9, 10, 13-15, and 17-20 have been considered but are moot in view of the new ground(s) of rejection. The applicant has set forth new grounds of rejection (see above) to address the new limitations.

Allowable Subject Matter

4. Claims 21-24 are allowed.

5. The following is an examiner's statement of reasons for allowance: The reasons for allowance have been discussed in the previous Office Action (see previous claims 8, 11, 12, and 16).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

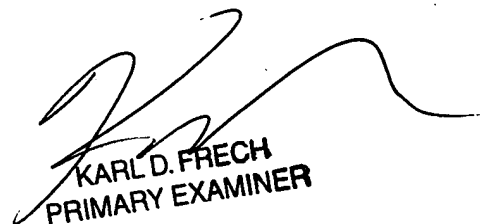
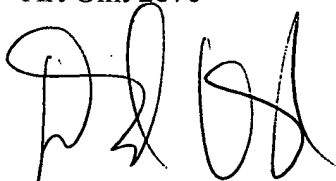
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Keller (US 5,700,037).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876



KARL D. FRECH
PRIMARY EXAMINER